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PATENTREMARKS

Applicant has thoroughly considered the Examiner's remarks and requests reconsideration of the application. Claims 1-37, 47-48, 50, and 55-58 are presented in the application for further examination. Claim 49 has been canceled, and claims 18, 28, and 47 have been amended by this Amendment B. The following remarks will follow the sequence of the Office action (the numerals at the beginning of the paragraphs below correspond to the numbered paragraphs of the Office action).

**Response to Claim Rejection under 35 U.S.C. § 102(b)**

1.-2. Claims 18-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bergsman et al. (U.S. Patent No. 5,568,539). A claim is anticipated only if each and every element as set forth in the claim is disclosed, either expressly or inherently in a single prior art reference.<sup>1</sup> Applicant submits that each and every element as set forth in the recited claims is not found, either expressly or inherently, in the Bergsman reference. Thus, the Bergsman reference does not anticipate the claims.

The Examiner argues that Bergsman et al. disclose "*an apparatus for recording and sending audio messages to an interactive voice response (IVR) system coupled to a communications network*" as set forth in claim 18. In particular, the Examiner asserts that system 300 of the Bergsman reference, which includes a processor 310, a memory 305, a telephone message storage driver 325, and an interface card 320, corresponds to the IVR system recited in claim 18. But Applicant notes that even if the Bergsman reference discloses such an IVR system, it is still entirely silent as to an end-user apparatus that includes *a processor, a memory device, computer instructions stored in the memory device, a microphone, and an interface*. That is, even though system 300 of the Bergsman reference includes the processor 310, the memory 305, the telephone message storage driver 325, and the interface card 320, it nonetheless is still merely a message storage system that stores an audio message on behalf of a message sender for delivering the audio message to its intended recipient at a later time. In

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<sup>1</sup> *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

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contrast, the apparatus recited in claim 18 is an end-user apparatus that is intended for end-users (for example, senders) to record and send an audio message.

The only end-user device disclosed in the Bergsman reference is a telephone used by, for example, a telephone user 350. This telephone of the Bergsman reference is a conventional telephone that does not include *a processor, a memory device, computer instructions stored in the memory device, a microphone, and an interface*. In fact, the Bergsman reference "requires the recipient to be able to control his or her experience by way of generating recognizable tones." In other words, the only end-user device disclosed by Bergsman et al. is a touch-tone telephone, thus eliminating any possibility that Bergsman et al. contemplate an end-user device that has *a processor, a memory device, computer instructions stored in the memory device, a microphone, and an interface*.

To more clearly set forth the invention, claim 18 has been amended to recite that *an audio message is transmitted through the communication network to the IVR system for delivery to a recipient via a remote device specified in a profile of the recipient*. Applicant submits that neither Bergsman et al. nor other references cited by the Examiner disclose that a recipient may specify in his or her profile a remote device to receive an audio message.

In light of the foregoing, Applicant submits that Bergsman et al. fail to disclose each and every element of claim 18. And claim 18 is believed to be allowable over the cited art.

Claims 19-23 depend from claim 18 and are believed to be allowable over the prior art for at least the same reasons that claim 18 is allowable over such art.

#### Response to Claim Rejection under 35 U.S.C. § 103(a)

3.-4. Claims 1-17 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergsman et al. in view of Picard et al. (U.S. Patent No. 6,233,318) and in further view of Groner (U.S. Patent No. 6,507,643). With regard to claim 1, the Examiner argues that the Groner reference teaches *a user profile for an intended recipient that specifies one or more communication devices by which such intended recipient should receive delivery or notification of voice messages directed to such intended recipient*. Applicant respectfully disagrees. The Groner reference discloses nothing more than a speech recognition system as applied to voice and electronic message mailing. (Groner, Abstract). Particularly, the Groner

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reference only teaches that after an audio message from a caller is received, a text message file is generated and sent to an intended recipient's e-mail address. (*Groner, Abstract*). Even though the Groner reference discloses "subscriber profile information," Applicant notes that the profile information of the Groner reference is merely used to "indicat[e] times of the day or week at which voice mail messages are to be converted into text and sent to [a recipient] as e-mail messages." (*Groner, col. 9, lines 36-39*). The Groner reference is entirely silent as to *a user profile specifying one or more communication devices for receiving delivery or notification of voices messages*.

In addition, the essence of the Examiner's position relates to the argument that it would be obvious to apply the teachings of Bergsman et al. that relate to providing an intended recipient with options as to when he or she will hear a voice message, to the totally unrelated system and method of Picard et al. relating to access of multimedia mailboxes, and to the totally unrelated system and method of Groner relating to speech recognition. Thus, the three references primarily cited by the Examiner are a mere aggregation based on hindsight analysis of the claim.<sup>2</sup> No reference suggests the applicability of Picard et al. or Groner to an IVR system as recited by claim 1. Without such a teaching, the obviousness rejection falls short and must be withdrawn. "[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination."<sup>3</sup> As has been shown, the non-analogous teachings of the prior art relate to different fields of endeavor and are directed to entirely different problems. Therefore, nothing in the cited references suggests their combination.

In light of the above, Applicant submits that Bergsman et al. in combination with Picard et al. and Groner fail to teach each and every element of claim 1. And claim 1 is believed to be allowable.

<sup>2</sup> See *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) ("There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.").

<sup>3</sup> *Lindemann Maschinenfabrick GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984).

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Claims 2-17 depend from claim 1. Therefore, claims 2-17 should be allowable for at least the same reasons that claim 1 is allowable over such art.

Claim 27 depends from claim 18 and is believed to be allowable for at least the same reasons that claim 18 is allowable over such art.

5. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergsman et al. in view of Angus (U.S. Patent No. 6,538,561). Applicant respectfully disagrees. Specifically, the Angus reference teaches nothing more than a system that reduces or eliminates long distance links that are subject to toll charges. Applicant does not understand how such reduction or minimization of long distance links would relate to the Bergsman reference's teaching of providing an intended recipient with options as to when he or she will hear a voice message. The non-analogous teachings of the prior art relate to different fields of endeavor and are directed to entirely different problems. Thus, nothing in the cited references suggests their combination.

In any case, claim 24 depends from claim 18. Accordingly, claim 24 should be allowable for at least the same reasons that claim 18 is allowable over such art.

6. Claims 25-26, 28-37, 47-48, 50, and 55-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergsman et al. in view of Picard et al. Regarding claims 25-26, Applicant notes that they depend from claim 18. Therefore, claims 25-26 are believed to be allowable for at least the same reasons that claim 18 is allowable over such art.

Regarding claim 28, the Examiner argues that the Picard reference discloses recording and sending an audio message using a computer device having a microphone and a network interface. Applicant has amended claim 28 to recite that an *audio file is communicated to a recipient via a remote device specified in a profile of the recipient*. As discussed with regard to claim 1 above, Applicant submits that none of the references cited by the Examiner discloses a profile that specifies a remote device to receive an audio file. Thus, claim 28, as amended, is believed to be allowable over such art.

Claims 29-37 depend from claim 28 and are believed to be allowable for at least the same reasons that claim 28 is allowable over such art.

Regarding claim 47, the Examiner argues that Picard et al. disclose sending an electronic message that includes a hyperlink to a stored voice message. Claim 47, as amended, now recites *"receiving information from the intended recipient specifying a device through which the*

*intended recipient desires to receive the voice message, contacting the device specified by the intended recipient, and delivering the voice message to the intended recipient through the specified device."* In rejecting canceled claim 49, the Examiner argues that Bergsman et al., at column 4, lines 26-45, disclose such receiving information that specifies a device to receive a voice message, contacting the device, and delivering the voice message to the intended recipient through the specified device. But Applicant notes that Bergsman et al., at column 4, lines 26-45 teach nothing more than pressing a button of a touch-tone telephone to transmit the option selected by the intended recipient as to when to receive the voice message. Applicant further submits that none of the other references cited by the Examiner discloses *receiving information that specifies a device to receive a voice message*, as recited in amended claim 47. Accordingly, claim 47 is believed to be allowable over such art.

Claims 48 and 50 depend from claim 47. Therefore, claims 48 and 50 should be allowable based on their dependency from claim 47.

Regarding claim 55, the Examiner asserts that Picard et al., at column 8, lines 21-41, disclose *"contacting the user via a second device associated with the user" and "receiving the audio message from the user via the second device."* A fair reading of the Picard reference suggests that Picard et al., at column 8, lines 21-31 merely disclose that if some structures of a non-voice message are too complicated to output to a voice telephone, then the non-voice message is not converted to a voice message, and the system explains to a subscriber that the non-voice message cannot be retrieved from a Dual Tone Multi-Frequency (DTMF) telephone. Further, the Picard reference, at column 8, lines 32-41, only teaches that a caller can send text messages containing a callback phone number to a subscriber's cellular handset or pager for the subscriber to reply the text messages. Applicant does not understand how such explanation that the non-voice message cannot be retrieved from a DTMF telephone and such text messages that contain a callback phone number would disclose *receiving information from a first device associated with a user, contacting the user via a second device, and receiving an audio message from the second device*, as recited in claim 55. Applicant submits that Bergsman et al. in combination with Picard et al. fail to teach each and every element of claim 55. Accordingly, claim 55 should be allowable over such art.

Claims 56-58 depend from claim 55. Therefore, claims 56-58 should be allowable based on their dependency from claim 55.

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PATENT**Conclusion**

8. The other references made of record and not relied upon are cumulative and no more relevant than the reference already applied by the Examiner. Thus, the amended claims distinguish over the prior art and are patentable.

9. It is felt that a full and complete response has been made to the Office action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, he is invited to telephone the undersigned.

Any required fees or overpayments should be applied to Deposit Account No. 19-1345.

Respectfully submitted,



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